

PATENT
P54757RE2

REMARKS

Claims 1 through 54 are pending in this application.

On 18 October 2005, the Examiner telephoned Applicant's undersigned attorney and required a restriction between:

- Group I, defined by claims 1 through 31, 33 through 49, 53 and 54 drawn to forming and processing a data address mark, classified in class 360, subclass 49; and
- Group II, defined by claims 32 and 50 through 52, drawn to a controller regulating head movement based on a data address mark, classified in class 360, subclass 77.06.

Applicant respectfully traverses the election requirement imposed, but provisionally elects with traverse Group I, claims 1 through 31, 33 through 49, 53 and 54.

Applicant objects to and traverses the election requirement on the grounds that the subject matter of the two groups overlap. In addition, the mandatory fields of search for the two embodiments are coextensive. Moreover, it appears from the text of the Office communication that the restriction requirement is being imposed merely for administrative convenience and such a basis for imposition of a requirement for restriction has been prohibited in previous decisions of the

-2-

BEST AVAILABLE COPY

PATENT
P54767RE2

Commissioner. Specifically, as is stated in *MPEP* §803, the Examiner must show that the (A) The inventions must be independent (*see MPEP* §802.01, §806.04, §808.01) or distinct as claimed (*see MPEP* §806.05 - §806.05(i)); and (B) there must be a serious burden on the Examiner if restriction is not required (*see* the mandatory requirements set forth in *MPEP* §803.02, §806.04(a) - §806.04(i), §808.01(a), and §808.02). These requirements have been made mandatory upon the Examining Corps, and may not be evaded. The unnumbered Paper issued by the Examining staff on Tuesday, the 18th of is completely devoid of any effort to satisfy these mandatory demonstrations of (a) independent or distinct inventions and (b) demonstration of a serious burden imposed upon the Examining staff absent restriction. Consequently, there is no basis for maintaining this requirement, and its withdrawal is respectfully urged.

It is respectfully submitted that there would not be a serious burden upon the Examiner in searching the invention species (a) through (g).

First, the Examiner has failed to show any kind of burden. The Examiner has failed to show that the different embodiments are in different classes or that such search would require not just a burden but rise to level of a serious burden. As stipulated in *MPEP* §803, if the search can be made without serious burden, the Examiner must examine it on the merits even if there are separate and distinct inventions. The Examiner has not alleged any serious burden and thus the Examiner must examine the entire application. Moreover, because no burden was shown, if the restriction is not withdrawn in the next office action, a finality on the restriction requirement cannot be made according to *MPEP* §706.07.

Second, rising to level of a *serious* burden is seriously suspect, especially in light of the

PATENT
P54757RE2

generic claims involved. Therefore, there would be no serious burden on the Examiner and as required by *MPEP* §803, the Examiner must examine the entire application on the merits.

Third, *MPEP* §806.03 states that:

“Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition” (emphasis supplied).

Why, then has this prohibition been violated in the above-captioned application where a single embodiment has been disclosed? That fact that Applicant’s claims are very broad in scope, and cover a plethora of implementations of the principles of Applicant’s inventions, is not a basis for violating this prohibition against restriction. Withdrawal of this requirement is therefore respectfully urged.

Fourth, the requirement is improper under current U.S. restriction practice, because the requirement is untimely. Under 37 CFR §1.146¹,

“[i]n a first action on an application containing a generic claim to a generic invention (genus) and more than one patentably distinct species embraced thereby, the examiner may require the applicant ... to elect a species”

Four (4) office actions have been already issued in the present application. Furthermore, the pending claims have already been examined on the merits. There is no reason, at this stage of the compacted examination, to now impose a restriction requirement. Its withdrawal is respectfully requested.

¹

37 CFR §1.146

PATENT
P54757RE2

If the requirement for restriction is not removed, then the Applicant reserves the right to petition the requirement, because there is no *serious* burden upon the Examiner in searching the invention Group I and Group II.

Therefore, the Applicant respectfully submits that the restriction requirement should be removed.

In view of the above, it is requested that the election requirement be withdrawn. It is further submitted that the application is in condition for completion of this protracted and extended examination on the merits; early allowance is requested.

Respectfully submitted,



Robert E. Bushnell,
Attorney for the Applicant
Registration No.: 27,774

1522 "K" Street N.W., Suite 300
Washington, D.C. 20005
(202) 408-9040

Folio: P54757RE2
Date: 10/21/05
I.D.: REB/kf